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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,857	02/22/2002	Shinsuke Takahashi	Q68660	7570

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EXAMINER

KIM, SANG K

ART UNIT	PAPER NUMBER
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3654

DATE MAILED: 03/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/079,857

Applicant(s)

TAKAHASHI ET AL.

Examiner

SANG KIM

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 and 6-17 is/are pending in the application.
- 4a) Of the above claim(s) 1-3, and 10-13 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 6-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4, and 6-9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 4, the phrase, "wherein the chamfered portions of the outer peripheral surface of the paster roller which are opposed to portions in the range from 20 mm to 50 mm from both end portions of a web, which contact the outer peripheral surface of the paster roller, in a width direction", is indefinite and vague because of the following reasons listed below:

What portions are being opposed to the outer peripheral surface of the chamfered portions? What are end portions of a web? What is a width direction?

It appears as though the applicant was trying to say in claim 4, that portions of a web is aligned across from the outer peripheral surface of the chamfered portions and both edges of the web extends in the range from 20 mm to 50 mm from edges of a straight portion of the roller, and width of the web contacts the outer peripheral surface of the roller.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 6, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2030968 A.

GB '968 shows a roller (10) with chamfered portions (12) formed at both end portions of an outer peripheral surface thereof, wherein portions of a web (w') is aligned across from the outer peripheral surface of the chamfered portions (12) and both edges of the web extends from edges of a straight portion (11, 14) of the roller, and width of the web contacts the outer peripheral surface of the roller (10), as shown in figures 2-3.

GB '968 discloses the claimed invention expect for a specific range in width of the web extending from both edges of the straight portion roller and a range of angles of the chamfered portions. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a certain range in width and angle as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

The recitation in the claims that the apparatus has a paster roller, relates only to a possible or intended use of the device being claimed, but does not further structurally limit the device, since "the paster roller" is a self-contained description of the roller and no structures are corresponding to "the paster roller".

Claims 7-9 and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB 2030968 A, in view of Carlson, U.S. Patent No. 4756065.

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GB '968 does not show a coated elastic body on the outer peripheral surface of the core bar.

Carlson shows a coated elastic body (13) on the outer peripheral surface of the aluminum core bar, as shown in figures 2 and 4.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of GB '968, to add a coated elastic body as taught by Carlson, to minimize the shearing force exerted on the roller when it comes into contact with a rapidly moving web.

GB '968 in view of Carlson discloses the claimed invention except for a specific hardness range of the coated elastic body from 40 to 70. It would have been obvious to one having ordinary skill in the art at the time the invention was made to select a certain range of hardness as claimed, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. In re Aller, 105 USPQ 233.

Response to Arguments

Claims 1-3 and 10-13 are withdrawn from further consideration.

Claim 5 has been canceled.

Claims 14-17 have been added.

Applicant's arguments, see pages 7-8, filed on 12/16/03, with respect to the rejection(s) of claim(s) 6-9 under Namiki have been fully considered and are persuasive. Therefore, the rejection has been withdrawn. However, upon further consideration, a

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new ground(s) of rejection is made in view of GB 2030968 A, and Carlson, U.S. Patent No. 4756065.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sang Kim whose telephone number is (703) 305-3712. The examiner can normally be reached Monday through Friday from 8:00 A.M. to 5:30 P.M. alternating Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kathy Matecki can be reached on (703) 308-2688. The fax phone numbers are (703) 872-9326 for regular communications and (703) 872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

SK

3/5/04



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